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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,475	11/30/2001	Roger Proksch	41369/LTR/A656	4570
20985	7590	10/05/2005	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			PATIDAR, JAY M	
			ART UNIT	PAPER NUMBER
			2862	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/016,475	PROKSCH ET AL.	
	Examiner	Art Unit	
	Jay M. Patidar	2862	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 62-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 62-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. This communication is in response to applicants' amendment filed on July 18, 2005.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 2, two coils for inside coil form must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,62-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neff (2,452,862) in view of applicants admitted prior art (AAPA) & common knowledge in the art.

As to claims 1,62-68, Neff discloses a displacement apparatus including a first and second non-magnetic coil forms (2,6) with a common axis, each wound with at least one winding (3,4,5); the outside diameter of the first form with its winding or windings being smaller than the inside diameter of the second form (Note Fig. 2) so that each may be displaced relative to the other with the first form inside the second form; the winding on the movable form magnetically coupled to the winding on the stationary form and a circuit generating a signal responsive to relative displacement between the coil forms. Neff does not

explicitly disclose a means for reducing noise. Applicants admitted prior art teaches to remove Barkhausen noise from the output signal by various means (Note pages 5-6). Consequently, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Neff to have included a means to reduce the noise from the output signal as taught by applicants admitted prior art to enhance the sensitivity of the device.

Neff does not explicitly disclose that the forms are non-ferromagnetic. It is very common in the magnetic field art to have a coil form made from non-ferromagnetic material e.g. plastic bobbin. One ordinary skill in the art would have found it obvious to use non-ferromagnetic coil forms since they are very well known in the art for their use.

As to claim 2, Neff discloses two coils on inside coil form and one coil for outside coil form (Fig. 4).

As to claim 3, Neff discloses two coils on outside coil form and one for inside coil form (Fig. 1).

As to claim 69, the method claim 69 recited for using the apparatus in claims 64-66 are an inherent use of the apparatus of Neff & AAPA and are rejected on the same grounds. One of ordinary skill would find it inherent that the apparatus of Neff modified with AAPA and common knowledge in the art operates in the functional manner claimed by applicant.

4. Applicant's arguments filed on July 18, 2005 have been fully considered but they are not persuasive.

Applicant argues that the subject matter of claim 2 is shown in figure 3 which is not true. Figure 3 is nothing but figure 2 with circuit components. Claim 2 requires two or more windings on the smaller diameter coil form. This was clearly explained in the previous office action.

Applicant admits that applicants admitted prior art teaches how to remove noise from the output signals. However, applicant argues that it does not teach as to how to remove it. If noise is removed by merely using the non-ferromagnetic coil forms, then the rejection clearly states that the use of non-ferromagnetic coil forms are common in the art. Applicant's arguments are broader than the scope of the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. the details of noise removing means) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants statement regarding "rejection of myths", it is unclear to the examiner as to what is meant by this statement by the applicant. Applicant argues that Neff does not teach the non-ferromagnetic coil forms. Neff is silent about the coils forms 2 in figure 1. The coil forms in Neff may be non-ferromagnetic coil forms since this is what known in the art and is commonplace in the art. The coil forms are normally plastic bobbins. One ordinary skill in the art knows that. Note US 4,030,085 in which Neff was cited. Applicant is also requested to note other references on PTO-892 that recites plastic bobbin. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

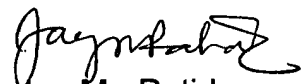
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay M. Patidar whose telephone number is 571-272-2265. The examiner can normally be reached on M-Thur 8:00-6:30.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jay M. Patidar
Primary Examiner
Art Unit 2862
September 29, 2005